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52

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,487	12/27/2000	John J. Giobbi	MD-1	5898

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Michael J. Blankstein
2014 Harrison Street
Evanston, IL 60201-2222

EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,487

Applicant(s)

GIOBBI, JOHN J.

Examiner

Jenise E Jackson

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04072005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Final Action

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Spies et al.(6,055,314).

3. As per claims 26, 38, 47, Spies et al. discloses a method of acquiring and playing digital content(see col. 2, lines 25-26), acquiring a physical key(i.e. IC card/smart card)(see col. 2, lines 50-67) containing key code from a key provider(see col. 5, lines 45-47, 55-67, col. 6, lines 19-28); requesting digital content from a content provider(see col. 4, lines 61-67, col. 5, lines 10-18); after locking(i.e. encrypt) the digital content with an unlock code associated with the key code contained in the physical key(see col. 3, lines 20-51), receiving the locked digital content; and entering the locked digital content into a playing device that reads the key code and determines whether the key code is associated with the unlock (see col. 2, lines 54-58, col. 3, lines 5-13, col. 6, lines 19-33), the device being enabled to unlock code(see col. 6, lines 19-33). Spies discloses a physical key being a physical object adapted to be carried by a user apart from the playing device(col. 5, lines 62-67, col. 6, lines 25-31).

Art Unit: 2131

4. As per claim 27, Spies et al. discloses the step of acquiring the physical key includes providing the key provider with user identification for use by the key provider in establishing a user account, the user account including the user identification information and the key code(see col. 8, lines 26-55, col. 15, lines 60-67, col. 16, lines 1-2).

5. As per claim 28, Spies et al. discloses including providing the content provider with the key code for use by the content provider in validating the key code prior to providing the locked digital content(see col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).

6. As per claim 29, Spies et al. discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 3, lines 19-51, col. 6, lines 15-33).

7. As per claim 30, Spies et al. discloses wherein the step of acquiring the physical key(see col. 2, lines 25-26) includes accessing a first web site of the key provider, and requesting the physical key via the first web site(see col. 8, lines 44-46), and wherein the step of requesting the digital content includes accessing a second web site of the content provider, and requesting the digital content via the second web site(see col. 6, lines 34-58).

8. As per claim 31, Spies et al. discloses wherein the physical key is acquired at no charge, and wherein the digital content is purchased(see col. 2, lines 54-58).

9. As per claim 32, Spies et al. discloses a method of managing digital rights(see col. 2, lines 25-31). Further, limitations have already been addressed(see claim 26).

10. As per claim 33, Spies et al. discloses establishing a user account including user identification information and the key code for the requesting user prior to the step of providing the physical key(col. 8, lines 26-55, col. 15, lines 60-67, col. 16, lines 1-2).

Art Unit: 2131

11. As per claim 34, Spies et al. discloses obtaining and validating the key code for the requesting user prior to the step of providing the locked digital content(see col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).

12. As per claim 35, Spies discloses including administering a first web site for receiving a request for the physical key from the requesting user(see col. 8, lines 44-46), and administering a second web site for receiving a request for the digital content from the requesting user (see col. 6, lines 34-58).

13. As per claim 36, Spies discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 3, lines 19-51, col. 6, lines 15-33).

14. As per claim 37, Spies discloses wherein the physical key and the playing device include respective wireless transceivers for communicating the key code from the key to the playing device, is inherent in Spies because Spies discloses that the system can be in the form of wireless communications, such as RF communications(see col. 14, lines 55-58).

15. As per claim 38, it is rejected under the same basis as claim 26.

16. As per claim 39, limitations have already been addressed (see claim 33).

17. As per claim 40, Spies et al. discloses wherein the means for providing the locked digital content to the requesting user includes a web site on the Internet(see col. 6, lines 34-58).

18. As per claim 41, Spies et al. discloses wherein the means for providing the locked digital content secures validation of the key code prior to providing the locked digital content(col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).

19. As per claim 42, it is rejected under the same basis as claim 33.

Art Unit: 2131

20. As per claim 43, Spies et al. discloses wherein the means for providing the physical key includes a web site on the Internet (see col. 8, lines 44-46).

21. As per claim 44, limitations have already been addressed (see claim 26).

22. As per claim 45, Spies discloses wherein the digital content is locked by encryption and unlocked by decryption (col. 3, lines 19-51, col. 6, lines 15-33).

23. As per claim 46, Spies discloses wherein the physical key and the playing device include means for communicating the key code to the playing device(see col. 6, lines 19-33).

Response to Amendment

24. The Applicant states that Spies does not disclose a method of acquiring and playing digital content. The Applicant states that Spies discloses video content and makes no mention of digital content. The Examiner disagrees with both comments made by Applicant. Spies does disclose digital content, because Spies discloses a system and method for secure purchase and delivery of video content programs over various distribution media including digital video disks(DVD)(see col. 2, lines 26-29). Further, Spies discloses digital video data(see col. 3, lines 53, col. 10, line 19, col. 12, lines 49-52, 61). Spies does discloses a method of acquiring and playing digital content, because Spies discloses a purchaser that wants to purchase a video, the merchant downloads decryption capabilities unique to the selected video content program to the IC card(see col. 2, lines 54-58). Thus, with the IC card with the decryption capabilities the purchaser is able to play the digital content.

25. The Applicant states that claim 38 is a system claim, and claim 47 is a method claim. The Applicant states that claim 38 and 47 are in the wrong statutory class. The Examiner disagrees with the Applicant. Claim 38 is a system, and it operates with a method. A system has

Art Unit: 2131

certain steps or methods it takes in order to perform a task. A method, has certain steps in order to be implemented or to be able to work within a system. Spies discloses a system and method(see col. 2, line 25), and Spies is was and is rejected by both claims 38 and 47.

26. The Applicant states that Spies does not disclose acquiring a physical key. The Examiner disagrees with the Applicant. Spies discloses a purchaser can physically carry the IC card(see col. 2, line 62). Further, Spies discloses the IC card is a portable card-like device, the IC card is a smart car(see col. 5, lines 62-67).

27. The Applicant states that Spies physical key is content-centric, and the Applicant's key is user-centric. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Spies physical key is content-centric, and the Applicant's key is user-centric) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

28. The Applicant states that the Applicant's physical key is capable of communicating electromagnetically with a digital content player. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. physical key is capable of communicating electromagnetically with a digital content player) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2131

29. The Applicant states that Spies does not disclose containing a unique key code from a key provider. The Examiner disagrees with the Applicant(col. 5, lines 10-24).

30. The Applicant states that Spies does not disclose entering the locked digital content into a playing device that reads the key code and determines whether the key code is associated with the unlock code. The Examiner disagrees with the Applicant. Spies discloses that the purchaser browses the store selection and rents one or more video programs. The purchaser presents the IC card to the merchant. The IC card is verified, and the merchant transfers the cryptographic key for selected video program from the key store to the IC card. The purchaser is given the DVD and returns home to play the video program, and then the purchaser inserts the IC card into the disk player to decrypt the video content(see col. 6, lines 19-33).

31. The Applicant states that Spies does not disclose purchasing a copy of digital content for repeated use to build a digital content library. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. purchasing a copy of digital content for repeated use to build a digital content library) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

32. Again the Applicant has is arguing statutory class, the Examiner has already explained(see above).

Final Action

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2131

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/750,487

Page 9

Art Unit: 2131



April 7, 2005



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